

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT OF THE TTAB

APRIL 5, 99

U.S. DEPARTMENT OF COMMERCE
PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

re:Member Data Services, Inc.

v.

Blackbaud, Inc.

Opposition Nos. 102,500; 102,586; 102,587;
102,594; 102,600; and 103,161

Clifford W. Browning of Woodard, Emhardt, Naughton, Moriarty
& McNett for re:Member Data Services, Inc.

W. Jamison Cox of Smith, Cox & Associates for Blackbaud,
Inc.

Before Hohein, Hairston and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

re:Member Data Services, Inc. has opposed six
applications owned by Blackbaud, Inc. to register the
following marks: (1) RE:MEMBER for "add-on software modules
which allows (sic) an organization to handle all membership
needs: joining, renewing, upgrading, downgrading, lapsed and
dropped members and reporting and printing of membership

cards"¹; (2) RE:QUEUE for "add-on software modules which allows (sic) an institution to set up a sequence of reports or queries that can be run automatically and unattended"²; (3) RE:VOLUNTEER for "add-on software modules which allows (sic) an institution to organize and mange volunteer staff for specific assignments, availability, scheduling and contributed hours"³; (4) RE:ZIP for "add-on software modules which allows (sic) the import and/or export of data to a third party mail house for standardization of addresses as well as the attachment of zip+4 information to the zip codes"⁴; (5) RE:TRIBUTE for "add-on software modules which tracks (sic) all gifts made in memory or honor of individual(s), prints acknowledgments, and informs honorees and or family members of each contribution"⁵; and (6) RE:ALUM for "add-on software modules which allows (sic) a

¹ Application Serial No. 74/683,696, filed May 31, 1995. The claimed dates of first use and first use in commerce are 1994. This application is the subject of Opposition No. 102,500.

² Application Serial No. 74/683,691, filed May 31, 1995. The claimed dates of first use and first use in commerce are 1990. This application is the subject of Opposition No. 102,586.

³ Application Serial No. 74/683,692, filed May 31, 1995. The claimed dates of first use and first use in commerce are 1994. This application is the subject of Opposition No. 102,587.

⁴ Application Serial No. 74/683,690, filed May 31, 1995. The claimed dates of first use and first use in commerce are 1990. This application is the subject of Opposition No. 102,594.

⁵ Application Serial No. 74/683,695, filed May 31, 1995. The claimed dates of first use and first use in commerce are 1994. This application is the subject of Opposition No. 102,600.

school/college to maintain and utilize biographical elements used in the solicitation of alumni"⁶.

As grounds for opposition, opposer has made essentially the same allegations in its six notices of opposition, namely, that since long prior to applicant's filing date, opposer "has been engaged in the business of offering for sale goods and services including providing credit unions with use of a computer database to access account information and transact banking business and credit card services marketed through credit unions and computer programs, all under the trade name RE:MEMBER DATA SERVICES, INC."; that opposer's use of its trade name has been continuous, and has become well known "to consumers and others in the computer, credit union and financial industries"; that because of the high quality of opposer's goods and services, and the extensive use of its trade name in advertising, "the relevant public has come to associate Opposer's goods and services with its RE:MEMBER DATA SERVICES, INC. trade name"; that applicant's use of its marks will lead the public to believe that applicant's goods originate from or are sponsored by opposer, or that opposer is in some way associated with applicant; and that applicant's marks, when used on its goods, so resemble

⁶ Application Serial No. 74/683,697, filed May 31, 1995. The claimed dates of first use and first use in commerce are 1994. This application is the subject of Opposition No. 103,161.

opposer's previously used trade name, as to be likely to cause confusion, mistake, or deception.

In its answers, applicant denied the salient allegations of the notice of opposition, and raised the affirmative defenses of laches and estoppel, as well as the putative defenses of opposer's failure to mitigate its damages (if any) and that sustaining the oppositions would grant opposer a *de facto* registration without observing the statutory requirements therefor.⁷

Opposer's motion to consolidate the six oppositions was not contested, and because the cases involved common questions of law and fact, the Board consolidated the proceedings on January 3, 1997.

The record consists of the pleadings; the files of the six opposed applications; the testimony, with exhibits, of David Bruce Becker, opposer's president and chief executive officer; the testimony, with exhibits, of Nigel Cooper, applicant's vice president of technology services; and the testimony, with exhibits, of Catherine Marshall, applicant's marketing manager.

⁷ Applicant submitted no evidence on its asserted defenses, and did not argue any of the defenses in its brief. Thus, applicant's affirmative defenses will not be further considered. (Moreover, as to applicant's fourth "affirmative defense," a plaintiff may base a notice of opposition or a petition for cancellation on alleged common law rights in a trademark, or a trade name, or on use analogous to trademark use. If such a plaintiff prevails on the record at trial, that does not grant a *de facto* registration to that plaintiff, rather it is a recognition of prior proprietary rights.)

Both parties filed briefs on the case⁸. An oral hearing was not requested.

David Bruce Becker, opposer's president and CEO, testified that when he worked for the Indiana Credit Union League (hereinafter ICUL), a state trade association for credit unions in Indiana, one bank supplied data processing for credit unions throughout Indiana; that at ICUL he researched an alternative data processing vendor, but because the ICUL failed to review the business plan he wrote to start an internal data processing service, in April 1981 he quit his job at ICUL; that also in April 1981 he founded re:Member Data Processing Services, Inc.⁹; and that "re:Member" was chosen as part of the trade name to distinguish opposer from the existing data processing

⁸ In its reply brief, opposer requested that the Board strike those portions of applicant's brief wherein applicant argued with reference to the specimens in its six involved applications. The Board does not generally strike arguments in a brief, but we will consider a party's objections and any improper portion(s) of a brief will be disregarded. See TBMP §540. Opposer's request that portions of applicant's arguments in its brief be stricken is denied. However, opposer is correct that the specimens from an application are not automatically of record in an *inter partes* case. See Trademark Rule 2.122(b)(2).

Opposer also argued in its reply brief that because applicant did not brief the second of the factors listed in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973), namely, the similarity or dissimilarity of the goods or services, applicant has conceded that its goods are similar, if not identical, to opposer's goods and services. Opposer is incorrect. A defendant is not required to file a brief at all. See TBMP §801.02(b). Moreover, we note, in particular, that applicant denied the allegations of opposer's notice of opposition wherein opposer alleged that the goods and services are similar, if not identical, leaving opposer to its proof.

⁹ In late 1983 or early 1984 the word "Processing" was dropped from the corporate name.

sources for Indiana's credit unions and to provide an advertising focus within the trade name on the relationship of the opposer's services to the members of credit unions servicing their members. In 1981, opposer created a newsletter published periodically under the mark "re:Memo," which is still used through distribution to opposer's client base and also as a direct mailing to credit unions across the country.¹⁰

Mr. Becker testified about the nature of credit unions, explaining that they are nonprofit corporations organized and chartered by state or federal laws, focused around a common bond, and owned by the depositors and/or the members of the credit union. Deposits are considered shares within the organization and the depositors have the right to vote to elect governing bodies. The board of directors consists of volunteers, usually members of the credit union or from the sponsor organization. The key to forming a credit union is a common bond, and there are numerous types of organizations with credit unions, such as educational institutions (Indiana University, Purdue University), manufacturers (Allison's, Dana Federal), trade associations (National Geographic), state or federal employees

¹⁰ In addition, he testified that in 1986 opposer released a product called "re:View" which was "a PC-based front end to the data center product" (dep., p. 14) but opposer stopped using the mark "re:View" in 1989.

(Indianapolis Police), and hospitals and health care providers (Methodist Hospital in Indianapolis).¹¹

Mr. Becker further testified that initially opposer offered online realtime service bureau services (i.e., opposer purchased time from a software house in Michigan on a wholesale basis, and resold it at retail to credit unions in Indiana); that within the year opposer's services expanded to include online realtime ATM (automated teller machines) networks and EFT (electronic funds transfer) services. In 1989 opposer acquired Custom Computer Applications, which had a credit union software package under the trademark "cuStar", allowing opposer to offer either a service bureau system, or alternatively to offer a significant in-house software product to its credit union customers. Mr. Becker explained the "cuStar" software is a central information file under which the credit union can identify each of its members by a single account number (one could have up to 3000 different products such as savings certificates and loans under one identification number); and that the "cuStar" product has a core system for the basics of credit union operations (e.g., general ledger, savings, checking, loans, CDs, payroll); and that there are add-on modules (e.g., ATMs, fixed assets audio response services

¹¹ The Board takes judicial notice of The American Heritage Dictionary definition of "credit union" as "A cooperative

for telephone banking, loan origination, mortgage origination and/or servicing, financial investment tracking).

Mr. Becker continued with the facts regarding opposer's growth, stating that in August 1992 opposer incorporated re:Member Data Services International, Inc. for the purpose of marketing re:Member products outside the United States; that in May 1993 opposer created re:Member Marketing Services as a full service advertising agency focusing on financial institutions; and that in 1996 opposer created home pages on the world wide web for re:Member Data Services, Inc., and re:Member Marketing Services.

None of opposer's add-on modules are sold under any trademark that begins with "re:". (dep., p. 46). He stated that opposer always uses "re:" in lower case lettering; and the "re:Member" portion of opposer's trade name is in a predominate font and style over the "Data Services, Inc." portion of opposer's trade name (as reproduced below).

Opposer's current customers number about 107 credit unions (of the 12,700 credit unions nationwide) in 32 states; that opposer has been spending approximately

organization that makes loans to its members at low interest

\$300,000 annually for advertising all of its goods and services (approximately \$10,000 of which is attributed to the promotion of opposer's international corporation and \$50,000 is attributed to promoting the marketing services corporation) (dep., p. 62); and that opposer's gross sales for the last two fiscal years were \$8.4 million and \$9.2 million. Opposer's "cuStar" products range in price from \$4,000 for the add-on modules for the base product to \$750,000 for the core "cuStar" product (with a price variance depending on the assets and membership of the organization).

Opposer sells its products and services through regional sales staff, who conduct sales solicitations and/or conclusions of sales through face-to-face meetings with credit union personnel. Opposer does some telemarketing. Opposer advertises in national credit union trade journals (e.g., Credit Union Magazine, Credit Union Times, Credit Union Executive, Indianapolis Business Journal, The Federal Credit Union); and participates as an exhibitor at national and regional credit union oriented trade shows. Opposer does not advertise in generic nonprofit trade journals, or exhibit at any nonprofit conference other than those involving credit unions; and opposer's sales staff does not call on charitable organizations, nor any nonprofits other

rates." See TBMP §712.01.

than credit unions. Opposer has never sold its products to any charity organization, nor to any nonprofit organization other than credit unions.

Mr. Becker testified that about 99% of opposer's goods and services are within the credit union field and have been since opposer's founding in 1981. When asked regarding plans to expand, Mr. Becker stated opposer is looking into "possibly the savings and loan and banking marketplace" (dep., p. 50).

Incorporated in 1981, applicant develops computer software for nonprofit organizations to better develop, administer and monitor their fund raising activities. Applicant's flagship product is sold under the mark THE RAISER'S EDGE, and the add-on modules are sold under various "RE" (Raiser's Edge) marks, such as the six opposed marks herein, as well as applicant's registered mark RE:EVENT¹². Applicant's add-on modules are products already embodied within THE RAISER'S EDGE product, and each module is a key to enable a particular feature to be used. These add-on modules cannot be purchased as a stand-alone product, but

¹² Reg. No. 1,976,529, issued May 28, 1996, for "add-on software modules which enables an institution to organize and manage any special event or fund-raising effort in the form of banquets, class reunions, dances, auctions, sporting events, etc.". When opposer's witness, Mr. Becker, was asked why his company did not oppose this application owned by applicant he responded "I don't know" (dep., pp. 68-69).

rather, they can only be purchased and used by someone who purchases applicant's flagship product THE RAISER'S EDGE to help raise charitable donations. That is, applicant's add-on software modules can operate only in conjunction with applicant's THE RAISER'S EDGE program, each one performing a task which is useful and supplemental to the fund raising administration functions of the flagship product.¹³

Applicant always uses these marks with the "RE:" portion in capital letters.

Applicant's customers are nonprofit organizations such as schools and universities chronicling information on alumni, and hospitals chronicling information on ex-hospital patients, or anyone who may donate money. Applicant's flagship program will track gifts, financial summaries of donations and "allow a fundraising department and development office within those institutions to manage their fundraising portfolio." (Cooper dep., p. 7).

¹³ RE:MEMBER is a module that allows any institution with membership type programs (e.g., art galleries clubs) to specifically track when the member joined, made gifts, upgraded, downgraded, etc.; RE:ALUM is a module that allows the institution to track specific alumni-type information on an individual; RE:QUEUE is a module that allows organizations to batch various processes to run in an unattended mode; RE:TRIBUTE is a module that allows hospitals and health care organizations to track gifts given in memory or in honor of someone; RE:VOLUNTEER is a module that allows organizations to track hours, and various capabilities of the individual volunteers; and RE:ZIP is a module that provides address corrections, add nine digit zip codes, and formats addresses to be compatible with the Post Office.

Applicant's vice president of technology services, Nigel Cooper, testified that the marks RE:ZIP and RE:QUEUE were first used in 1990. Mr. Cooper was not clear on the specific introduction dates of applicant's other involved "RE:" marks, but generally referred to transitioning from a DOS product line to a Windows product line at the end of 1993 and 1994 (Cooper dep., pp. 12-13), and coming up with a group of the "RE:" prefix marks for the add-on modules at that time.

Applicant's involved goods are not advertised alone, but are advertised only as part of the flagship product. Applicant advertises in nonprofit magazines such as The Chronicle of Philanthropy, Foundation News, Fundraising Management and Nonprofit Times, but places no advertising in credit union trade journals. Applicant also markets its involved products through direct mailings, including three significant mailings per year to around 45,000-60,000 organizations. These direct mail advertisements are sent to schools, colleges, museums, hospitals, zoos, performing arts organizations, environmental organizations, social service organizations, youth organizations, and the like. In addition, applicant conducts seminars with an account executive from applicant doing a presentation in which materials on THE RAISER'S EDGE products are available; and applicant attends conferences of nonprofit organizations as

a vendor, bringing individualized brochures or sheets on applicant's products. Applicant exhibits at the trade shows of nonprofit organizations, but not those of credit unions. In 1996 applicant spent over \$100,000 on advertising, and 50-75% of that related to THE RAISER'S EDGE product.

Applicant basically sells its involved products through a sales force of 15-20 people, who conduct on-site presentations. There are also some in-house telephone sales, following up on leads regarding the add-on products. In 99% of applicant's sales there is a face-to-face meeting with applicant's sales representative. Applicant's THE RAISER'S EDGE product sells for \$6,000 and the various add-on modules cost \$1,000 or \$2,000 each. Applicant's total sales in 1996 were \$27 million, and are estimated at \$30-\$36 million dollars for 1997.¹⁴

Applicant has approximately 11,500 customers, all of which are nonprofit organizations, and none are credit unions or advertising agencies or savings and loans or banks. The only exception to the banks as customers of applicant is in a very few situations in which the trust department of a bank may seek applicant's Paragon stand-

¹⁴ Applicant sells outside the United States, but applicant did not specify whether these sales figures are for the United States only, nor did applicant specify whether these sales figures were for the products involved herein sold under the "RE:" marks.

alone software for tracking deferred giving (that is, bequests).

We turn first to a consideration of opposer's priority. Opposer has presented testimony regarding use of its trade name in the form "re:Member Data Services, Inc." since late 1983 or early 1984, while the record shows applicant's first use of the marks RE:ZIP and RE:QUEUE was in 1990, and its first use of RE:ALUM, RE:TRIBUTE, RE:VOLUNTEER and RE:MEMBER began sometime thereafter, perhaps around late 1993 or 1994. Opposer's priority based on its use of its trade name is clearly established, and applicant does not contend otherwise. See *Martahus v. Video Duplication Services Inc.*, 3 F.3d 417, 27 USPQ2d 1846 (Fed. Cir. 1993).

We turn then to the issue of likelihood of confusion. Our determination of this issue is based on an analysis of all the probative facts in evidence that are relevant to the factors bearing on likelihood of confusion. See *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). As dictated by the evidence, different factors may play more dominant roles in determining likelihood of confusion.¹⁵ See *Kenner Parker Toys Inc. v. Rose Art*

¹⁵ Opposer strenuously asserts that under the case of *Octocom Systems Inc. v. Houston Computer Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990), it is inappropriate for applicant to argue various du Pont factors without first explicitly showing why each factor is relevant herein. Further, opposer interprets the *Octocom* case to mean that factors such as (1) the similarity or dissimilarity of established, likely to continue trade channels; (2) the conditions under which and buyers to whom sales

Industries Inc., 963 F.2d 350, 22 USPQ2d 1453 (Fed. Cir. 1992); and Nina Ricci, S.A.R.L. v. E.T.F. Enterprises, 889 F.2d 1070, 12 USPQ2d 1901 (Fed. Cir. 1989).

Turning to the similarity or dissimilarity of the marks, we will first address this du Pont factor with respect to applicant's marks RE:ALUM, RE:TRIBUTE, RE:ZIP, RE:QUEUE and RE:VOLUNTEER. We must compare each of applicant's involved marks and opposer's trade name in their entirety. See *In re Hearst Corp.*, 982 F.2d 493, 25 USPQ2d 1238 (Fed. Cir. 1992); and *Opryland USA Inc. v. The Great American Music Show Inc.*, 970 F.2d 847, 23 USPQ2d 1471 (Fed. Cir. 1992). That is, the marks must be considered in the way they are used and perceived. Marks tend to be perceived in their entirety, and all parts thereof must be given appropriate weight. See Hearst, *supra*.

The fact that two marks, or in these cases applicant's marks and opposer's trade name, share a common term ("re:")

are made, i.e., "impulse" vs. careful, sophisticated purchasing; (3) the variety of goods on which a mark is or is not used (house mark, "family" mark, product mark); (4) the market interface between applicant and the owner of a prior mark; and (5) the extent of potential confusion, i.e., whether de minimis or established, are all "irrelevant and immaterial" because applicant's identifications of goods are not limited. Of course, in Board proceedings likelihood of confusion is determined on the basis of the goods as identified in the application and/or registration. But the Court in Octocom did not mean that several of the du Pont factors are "immaterial and irrelevant" based solely on the identification of goods in the application and/or registration. Rather, the factors are relevant, but must be determined in light of the identification of goods set forth in the application and/or registration. Evidence showing the

does not necessarily mean that the marks as a whole project the same image or impression. See *Olay Company, Inc. v. Avon Products, Inc.* 178 USPQ 502 (TTAB 1973). This is especially true where opposer's trade name is generally presented in the special form previously reproduced in this decision. Moreover, the word MEMBER is completely dissimilar to the words ALUM, TRIBUTE, ZIP, QUEUE and/or VOLUNTEER.

We find that applicant's marks RE:ALUM, RE:TRIBUTE, RE:ZIP, RE:QUEUE and RE:VOLUNTEER are dissimilar in sound, appearance, meaning and commercial impression from opposer's trade name "re:Member Data Services, Inc.".

Turning to a consideration of the similarity or dissimilarity of applicant's mark RE:MEMBER, and opposer's trade name, we utilize the same principles enumerated above. Obviously, applicant's mark is the same as part of opposer's trade name "re:Member Data Services, Inc.". That is, not only is the term "re:" the same, but the word MEMBER is a shared element in both applicant's mark and opposer's trade name. Further, the words "data services, inc." are highly descriptive if not generic of opposer's services. When considered in their entirety, we find that applicant's mark, RE:MEMBER, and opposer's trade name are highly similar.

conditions under which the goods, as broadly identified, are sold

We turn to a consideration of the parties' respective goods and services. Opposer has established that it offers online data processing services in the field of credit union management, either as a service bureau or alternatively, by selling the credit union customer an in-house data processing system under the trademark "cuStar". Opposer clearly sells only to credit unions and not to other nonprofit organizations. Opposer's advertising is limited to credit union trade journals and opposer's attendance at trade shows is limited to credit unions related ones only. Opposer's in-house core data processing system sells for around \$750,000, and the add-on modules are \$4,000 each. In these oppositions, opposer does not base its rights on a registration, hence its claimed common law rights are limited to those proven herein. That is, any limitations as to opposer's goods and services, channels of trade, purchasers, and the like are properly considered herein.

Applicant's goods must be considered as set forth in the applications. See *Canadian Imperial Bank of Commerce v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d 1813 (Fed. Cir. 1987); and *CBS Inc. v. Morrow*, 708 F.2d 1579, 218 USPQ 198 (Fed. Cir. 1983). The goods in applicant's six involved applications are each identified as "add-on software modules..." followed by wording identifying a specific

may be considered, however.

function, such as a module which allows an institution to organize and manage volunteer staff, or one which allows the institution to set up a sequence of reports that can be run automatically. To assist in a proper understanding of applicant's goods as identified, we take judicial notice of the dictionary definitions of the following terms: (1) The Computer Glossary (1998) defines "module" as "A self-contained hardware or software component that interacts with a larger system. Hardware modules are often made to plug into a main system. Program modules are designed to handle a specific task within a larger program."; and (2) the Dictionary of Computer Words defines "add-in" as "An accessory program designed to be used in conjunction with an existing application program to extend its capabilities or provide functions. For example, the spreadsheet application Lotus 1-2-3 can be supplemented with add-ins to analyze the logical structure of the spreadsheet, view spreadsheet files before actually retrieving them, or change the values in a spreadsheet formula to produce a desired outcome. Also called add-on."

Applicant's goods are supplemental "add-ons" to applicant's core software system, sold under the mark THE RAISER'S EDGE. While applicant's goods are not limited as to purchasers or trade channels, they are clearly limited by

function;¹⁶ and given the dictionary definition of "add-ins" as an accessory program, the identifications as written are limited in the sense that applicant's goods are clearly software modules to be added-on to an existing program. That is, purchasers and potential purchasers would understand that each of applicant's goods, as identified, is a computer module to be added to an existing program. Moreover, the record clearly shows that applicant's "add-on modules" are not sold separately from its flagship product to assist nonprofit organizations' fund raising efforts. These add-on software modules are not stand alone products and cannot be operated except in conjunction with applicant's fund raising software, THE RAISER'S EDGE. Applicant has no credit unions as customers, and seeks none, in that applicant does not advertise in credit union trade journals, and its sales force does not seek out credit unions.

Although applicant's identification of goods are not limited as to purchasers and trade channels (except to the extent such is logically limited by the function set forth in the identifications), and could therefore potentially include a wide range of purchasers, if applicant's goods

¹⁶ Applicant's original identifications of goods in all six applications stated "add-on module to The Raiser's Edge™ software application....". However, by Examiner's Amendment, the Examining Attorney changed each of the identifications of goods, including deleting applicant's reference to The Raiser's Edge.

were simply inexpensive, off-the-shelf computer software programs, then clearly they would not be marketed to the same purchasers as those purchasers seeking opposer's credit union data processing services or its \$750,000 core in-house system. Conversely, if applicant's goods were relatively expensive (as the record shows they are), then the purchasers for the parties' respective goods and services would be sophisticated and would make their purchasing decisions only after careful consideration. Accordingly, even assuming that opposer is correct that some of the same persons may be on the governing board of a nonprofit organization as well as on the governing board of a related credit union, and even if these persons are involved in the purchase of data processing and fund raising software, their deliberations would entail careful consideration and involve face-to-face sales presentations of expensive computer systems and software.

The record before us shows that the established and likely to continue trade channels are separate and distinct. There is at most a *de minimis* chance that purchasers or potential purchasers of opposer's services and goods would overlap with those seeking applicant's goods.

As applicant points out, there must be shown more than a mere possibility of confusion; instead, there must demonstrated a probability or likelihood of confusion. See

Electronic Design & Sales Inc. v. Electronic Data Systems Corp., 954 F.2d 713, 21 USPQ2d 1388, 1391 (Fed. Cir. 1992), quoting from Witco Chemical Company, Inc. v. Whitfield Chemical Company, Inc., 418 F.2d 1403, 164 USPQ 43 (CCPA 1969) as follows: "We are not concerned with mere theoretical possibilities of confusion, deception, or mistake or with *de minimis* situations but with the practicalities of the commercial world, with which the trademark laws deal." See also, Triumph Machinery Company v. Kentmaster Manufacturing Company Inc., 1 USPQ2d 1826 (TTAB 1987).

The Trademark Act does not speak in terms of remote possibilities of confusion, but rather, the likelihood of such confusion occurring in the marketplace. Given the differences between opposer's trade name and applicant's six marks (admittedly the mark RE:MEMBER is the closest to opposer's trade name), and looking at the evidence on the relevant du Pont factors in this case, it is our belief that the possibility of confusion in this case is a remote one.

Finally, the absence of any actual confusion, while weighing in applicant's favor, is not a crucial factor to our decision herein. (The absence of actual confusion is not surprising given the differences between applicant's marks and opposer's trade name, the differences in the customers and trade channels, the sophistication of

Opposition Nos. 102500, 102586, 102587, 102594, 102600 & 103161

purchasers being presented with in-person sales, and the expensive nature of the involved goods and services.)

Opposition Nos. 102500, 102586, 102587, 102594, 102600 & 103161

Decision: The oppositions are dismissed.

G. D. Hohein

P. T. Hairston

B. A. Chapman
Administrative Trademark
Judges, Trademark Trial and
Appeal